

REMARKS

This communication responds to the Office Action mailed on July 13, 2005. No claims are amended, no claims are canceled, and no claims are added. As a result, claims 1-28 are now pending in this Application.

Objections to the Drawings and Specification

An objection was raised to FIG. 4 in the drawings as failing to comply with 37 C.F.R. § 1.84(p)(5) because the reference characters “451” and “465” were included in FIG. 4, but not mentioned in the specification. The Applicant has amended specification paragraphs [0026] and [0028] to incorporate these reference characters, according to the text of FIG. 4. No new matter has been added. It is believed that this amendment addresses the concerns expressed by the Examiner, and renders the objections moot.

Additionally, Applicants submit herewith four sheets of formal drawings. It is believed that the drawings are in compliance with 37 CFR 1.84. No amendments are made to the drawings.

An objection was also raised to the specification due to textual informalities (i.e., periods left out at the end of paragraphs [0002] and [0027]). These paragraphs have been amended so as to obviate the objection, and the Applicant wishes to thank the Examiner for her thorough review of the specification in this regard.

§103 Rejection of the Claims

Claims 1-6 and 8-28 were rejected under 35 USC § 103(a) as being unpatentable over Jagadeesan et al. (U.S. 2005/0059400; hereinafter “Jagadeesan”) in view of Chen et al. (U.S. 6,606,485; hereinafter “Chen”). Claim 7 was rejected under 35 USC § 103(a) as being unpatentable over Jagadeesan/Chen and further in view of Petrus (U.S. 2004/0266474; hereinafter “Petrus”). First, the Applicant does not admit that Jagadeesan, Chen, or Petrus are prior art, and reserves the right to swear behind these references in the future. Second, since a *prima facie* case of obviousness has not been established in each case, the Applicant respectfully traverses these rejections.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d (BNA) 1596, 1598 (Fed. Cir. 1988). In combining prior art references to construct a *prima facie* case, the Examiner must show some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art that would lead an individual to combine the relevant teaching of the references. *Id.* The M.P.E.P. contains explicit direction to the Examiner that agrees with the *In re Fine* court:

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Appellant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d (BNA) 1438 (Fed. Cir. 1991)).

An invention can be obvious even though the suggestion to combine prior art teachings is not found in a specific reference. *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d (BNA) 1443 (Fed. Cir. 1992). However, while it is not necessary that the cited references or prior art specifically suggest making the combination, there must be some teaching somewhere which provides the suggestion or motivation to combine prior art teachings and applies that combination to solve the same or similar problem which the claimed invention addresses. One of ordinary skill in the art will be presumed to know of any such teaching. (See, e.g., *In re Nilssen*, 851 F.2d 1401, 1403, 7 U.S.P.Q.2d 1500, 1502 (Fed. Cir. 1988) and *In re Wood*, 599 F.2d 1032, 1037, 202 U.S.P.Q. 171, 174 (C.C.P.A. 1979)). However, the level of skill is not that of the person who is an innovator but rather that of the person who follows the conventional wisdom in the art. *Standard Oil Co. v. American Cyanamid Co.*, 774 F.2d 448, 474, 227 U.S.P.Q. 293, 298 (Fed. Cir. 1985). The requirement of a suggestion or motivation to combine references in a *prima facie* case of obviousness is emphasized in the Federal Circuit opinion, *In re Sang Su Lee*, 277 F.3d 1338; 61 U.S.P.Q.2D 1430 (Fed. Cir. 2002), which notes that the motivation must be supported by evidence in the record.

No proper *prima facie* case of obviousness has been established because either (1) combining the references does not teach all of the limitations set forth in the claims, (2) there is no motivation to combine the references, or (3) combining the references provides no reasonable expectation of success. Each of these points will be explained in detail, as follows.

Combining References Does Not Teach All Limitations: First, with respect to independent claims 1, 6, 15, 20, and 24, no combination suggested in the Office Action will render all of the claim limitations. The Office admits Jagadeesan fails to disclose “downloading a demodulation code” or “a module to download a demodulation code”, as claimed by the Applicant. Chen and Petrus have the same deficiency.

While the assertion is made in the Office Action that Chen discloses “downloading a demodulation code” at Chen, col. 8, lines 25-34, a close reading of Chen reveals that this is incorrect. Chen describes searchers and demodulators units 130, 230, and refers the reader to examples of such units in U.S. Patent Number 5,490,165, issued to Blakeney, II et al. (hereinafter “Blakeney”) attached hereto as Appendix A. See Chen, Col. 1, line 60 – Col. 2, line 7.

In FIG. 1 of Blakeney, a plurality of identical demodulation elements 204A ... 204N is shown. “In fact, within a multi-sector base station, a system may be configured such that each demodulation element may be assigned to any arriving signal regardless of the sector that signal was received from.” Blakeney, Col. 5, lines 23-26. Given that the demodulation units of Blakeney are held up by Chen as being examples of the searchers and demodulators units 130, 230, it is clear that the demodulators included in Chen’s searchers and demodulators units 130, 230 are identical. Thus, there is no need to download any demodulation codes. Further, the Applicant was unable to find any support in Chen for “downloading a demodulation code” or “a module to download a demodulation code”, as claimed by the Applicant.

No assertion was made by the Office that Petrus included this missing element, and no evidence was found by the Applicant to the contrary. Therefore no combination of Jagadeesan, Chen, or Petrus can provide these claimed elements, and independent claims 1, 6, 15, 20, and 24 are nonobvious. This conclusion applies with even greater force respecting all of the dependent

claims since any claim depending from a nonobvious independent claim is also nonobvious. See M.P.E.P. § 2143.03.

No Motivation to Combine References: The Office asserts that it would be obvious to combine Jagadeesan with Chen “to download the demodulation code of Jagadeesan as suggested by Chen.” However, this assertion overlooks the fact that Jagadeesan and Chen teach away from such a combination.

First, the mobile station 12 of Jagadeesan “includes dual-mode technology to support the transition from one network to another.” Jagadeesan, para. 14. The Applicant could find no mention of a way to download demodulation code into the mobile station 12 of Jagadeesan. In addition, since Jagadeesan’s dual-mode technology is already present in the mobile station 12, there is no motivation to download demodulation code – the required elements to hand off a call between networks is already present.

Second, Chen does not suggest downloading demodulation code, contrary to the assertion of the Office Action. As noted above, the demodulators included in Chen’s searchers and demodulators units 130, 230 are identical, and there is no need to download any code. Further, the Applicant was unable to find any mention of downloading demodulation codes in Chen. The portion of Chen cited by the Office (Chen, Col. 8, lines 25-34) merely describes the general nature of the demodulation process – downloading codes is not taught or suggested. Adding Petrus to the combination of Jagadeesan and Chen does nothing to remedy this deficiency.

It is respectfully noted that references must be considered in their entirety, including parts that teach away from the claims. See MPEP § 2141.02. Since Jagadeesan and Chen teach away from combination, there is no motivation to combine the references.

Finally, the use of unsupported assertions in the Office Action does not satisfy the explicit requirements needed to demonstrate motivation as set forth by the *In re Sang Su Lee* court. Therefore, the Examiner appears to be using personal knowledge, and is respectfully requested to submit an affidavit as required by 37 C.F.R. § 1.104(d)(2).

No Reasonable Expectation of Success: Modifying Jagadeesan to implement the asserted download activity of Chen will not provide an operative combination, since Chen does

not teach downloading demodulation code. Adding Petrus to this combination does nothing to remedy the deficiency that results.

Again, the use of unsupported assertions in the Office Action does not satisfy the explicit requirements needed to demonstrate motivation as set forth by the *In re Sang Su Lee* court. Therefore, the Examiner appears to be using personal knowledge, and is respectfully requested to submit an affidavit as required by 37 C.F.R. § 1.104(d)(2).

The test for obviousness under § 103 must take into consideration the invention as a whole; that is, one must consider the particular problem solved by the combination of elements that define the invention. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985). The fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01.

Therefore, since there is no evidence in the record that combining Jagadeesan, Chen, or Petrus results in apparatus or methods that operate to download demodulation codes, as claimed by the Applicant; since there is no motivation to supply the missing elements (because the references teach away from such a combination); and since no reasonable expectation of success arises, a *prima facie* case of obviousness has not been established with respect to independent claims 1, 6, 15, 20 and 24, or for any of the claims that depend from them. It is therefore respectfully requested that the rejections of claims 1-28 under 35 U.S.C. § 103 be reconsidered and withdrawn.

CONCLUSION

The Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone the Applicant's attorney, Mark Muller at (210) 308-5677, or Applicant's below-named representative to facilitate the prosecution of this Application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 13TH day of September 2005.

John D. Gustar-Watball

Name

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Signature